



## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Gosselin *et al.*

Serial No.: 10/022,276

Group Art Unit: 1623

Filed: December 14, 2001

Examiner: L. Eric Crane

For:  $\beta$ -L-2'-Deoxy-Nucleosides for the Treatment of Hepatitis BAssistant Commissioner for Patents  
Washington, DC 20231

July 17, 2002

**Terminal Disclaimer**

Sir:

Assignees, Novirio Pharmaceuticals Limited, Centre National de la Recherche Scientifique and the University of Montpellier II, the owners of entire interest of U.S. Serial Nos. 10/022,276; 09/371,747, now U.S. Patent No. 6,395,716; 09/459,150 and 10/022,148, through the undersigned agent of record, hereby disclaim the terminal part of any patent granted on U.S. Serial No. 10/022,276; 09/371,747, now U.S. Patent No. 6,395,716; 09/459,150 or 10/022,148 that would extend beyond the expiration date of the full statutory term of the other. Any patent granted on U.S. Serial No. 10/022,276; 09/371,747, now U.S. Patent No. 6,395,716; 09/459,150 or 10/022,148 shall be enforceable only for and during such period that legal title to one of the patents shall be the same as legal title to the other and will be binding upon the grantee, its successors or assigns.

Gilles Gosselin has assigned U.S. Serial Nos. 10/022,276; 09/371,747, now U.S. Patent No. 6,395,716; 09/459,150 and 10/022,148 to the Centre National de la Reserche Scientifique, while Martin Bryant has assigned U.S. Serial Nos. 10/022,276; 09/371,747, now U.S. Patent No. 6,395,716; 09/459,150 and 10/022,148 to Novirio Pharmaceuticals Limited, whose addresses are of record, in an Assignment recorded on September 27, 1999, commencing at Reel 010271,

07/30/2002 MVALARI 00000003 110980 10022276

01 FC:148

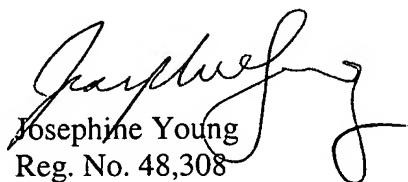
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Frame 0725. Jean-Louis Imbach has assigned U.S. Serial Nos. 10/022,276; 09/371,747, now U.S. Patent No. 6,395,716; 09/459,150 and 10/022,148 to the Université Montpellier II, whose address was filed in an Assignment mailed on May 24, 2002.

Assignees do not disclaim any terminal part of any patent granted on U.S. Serial No. 10/022,276; 09/371,747, now U.S. Patent No. 6,395,716; 09/459,150 or 10/022,148 prior to the expiration date of the full statutory term to the other of U.S. Serial No. 10/022,276; 09/371,747, now U.S. Patent No. 6,395,716; 09/459,150 or 10/022,148 in the event that such patent later: a) expires for failure to pay a maintenance fee, b) is held unenforceable, c) is found invalid, d) is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. § 1.321(a), e) has all claims canceled by a reexamination certificate, or f) is otherwise terminated prior to expiration of its statutory term, except for the separation of legal title stated above.

Please charge the \$110.00 fee for filing this Terminal Disclaimer, as well as any other fees required, to Deposit Account No. 11-0980.

Respectfully submitted,



Josephine Young  
Reg. No. 48,308

KING & SPALDING  
191 Peachtree Street  
Atlanta, GA 30303  
404-572-3541 (Direct Line)  
404-572-5145 (Facsimile)

ASSIGNMENT

THIS ASSIGNMENT, made by Centre National De La Recherche Scientifique (CNRS), a public agency operating under the supervisory authority of France's Ministry of Research and Technology, located at 3, Rue Michel-Ange 75794, Paris, Cedex 16, France, assigns to the L'Université Montpellier II (UMII), a Public Institution with cultural and professional vocation, located at 2 place Eugène Bataillon 34095 Montpellier Cedex 5, all rights received by CNRS from Jean-Louis Imbach by written assignment to the patents and patent applications listed in Attachment A. For avoidance of doubt, it is confirmed that this Assignment does not convey any of the ownership rights of CNRS arising out of the work of Dr. Gilles Gosselin in the patents and patent applications listed in Attachment A, and that the CNRS remains a co-assignee of all of the patents and patent applications listed in Attachment A by virtue of its ownership rights flowing from the work of Dr. Gilles Gosselin.

NOW, THEREFORE, To All Whom It May Concern, be it known that and other good and valuable consideration the receipt and sufficiency of which are hereby acknowledged, the above Assignor has sold and by these presents does hereby sell, assign, transfer and convey unto the said Assignee, and assigns the full title and interest of Jean-Louis Imbach in and to said Patents, in the inventions represented thereby and any and all reissues, renewals, divisions, continuations, and any other applications that claim priority thereto or from which these applications claim priority, letters Patent or continuations-in-part thereof; or any foreign counterpart thereof, and which may be granted therefor or thereon, for the full end of term for which said Letters Patent may be granted, and all applications, petitions, oaths and assignments or other papers and instruments which may be necessary in order to carry into full force and effect the sale, assignment, transfer and conveyance hereby made or intended to be made.

From time to time after the date hereof, at the request of either party hereto, and at the expense of the party so requesting, each of the parties hereto shall execute and deliver to such requesting party such documents and take such other action as such requesting party may reasonably request in order to consummate more effectively the transactions contemplated hereby.

HB

The Assignor further covenants and agrees that, at the time of the execution and delivery of these presents, it possesses full title to the inventions and Patents thereon as earlier identified, and that it has the unencumbered right and authority to make this assignment.

This Assignment has been drafted in the English and French language. In case of contradiction between the two versions, the French language document will prevail.

Centre National de La Recherche Scientifique  
Assignor

By Pour le Directeur Général  
et par Délégation  
Title Le Délégué aux Entreprises du Gouvernement

Joseph BAXERAS

## Attachment A

TITLE & DOCKET NAME	COUNTRY	FILING DATE	INVENTORS	SERIAL NUMBER	PATENT NUMBER	ISSUE DATE
NOV/1000 Provisional β-L-2'-Deoxy- Nucleosides for the Treatment of Hepatitis B	U.S. CON	8/10/98 04/28/99	Gilles Gosselin Jean-Louis Imbach	60/096,110 60/131,352		
NOV/1000 Normal β-L-2'-Deoxy- Nucleosides for the Treatment of Hepatitis B	U.S.	8/10/99	Gilles Gosselin Jean-Louis Imbach Martin L. Bryant	09/371,747		
NOV/1000 CON β-L-2'-Deoxy- Nucleosides for the Treatment of Hepatitis B	U.S.	12/14/01	Gilles Gosselin Jean-Louis Imbach Martin L. Bryant	10/022,276		
NOV/1000 CIP β-L-2'-Deoxy- Nucleosides for the Treatment of Hepatitis B	U.S.	12/10/99	Gilles Gosselin Jean-Louis Imbach Martin L. Bryant	09/459,150		
NOV/1000 CIP CON β-L-2'-Deoxy- Nucleosides for the Treatment of Hepatitis B	U.S.	12/14/01	Gilles Gosselin Jean-Louis Imbach Martin L. Bryant	10/022,148		
NOV/1000 PCT β-L-2'-Deoxy- Nucleosides for the Treatment of Hepatitis B	PCT	8/10/99	Gilles Gosselin Jean-Louis Imbach Martin Bryant	PCT/US99/18149	WO 00/09531	2/24/00
	Australia	8/10/99		54757/99		
	Brazil	8/10/99		9912896-9		
	Canada	8/10/99		2,340,156		

TITLE & DOCKET	COUNTRY	FILING DATE	INVENTORS	SERIAL NUMBER	PATENT NUMBER	ISSUE DATE
	China	8/10/99		99809553.2 CN1320128A		
	Europe	8/10/99		99941027.7 1 104 436 A	1 104 436 A	
	Hong Kong	8/10/99		01104418.5 1034083		
	India	8/10/99		INPCT/2001/ 00465/DEL	INPCT/2001/ 00194/DEL	
	India DIV1	8/10/99				
	Japan	8/10/99		2000-564981		
	S. Korea	8/10/99		2001-7001758		
	Mexico	8/10/99		1001507		
	Russian Federation	8/10/99		2001106651		
	Singapore	8/10/99		200102730-9		
NOV 1005 3'-Produgs of 2'-deoxy- $\beta$ -L- Nucleosides	U.S. Prov.	6/15/00	Martin L. Bryant; Gilles Gosselin Jean-Louis Imbach	60/212,100		
	U.S.	6/15/01		09/883,033		
	PCT	6/15/01		US01/19147		
	Argentina	6/15/01		010102881		
	Bolivia	6/15/01		007456		
	Chile	6/15/01		1381-2001		
	Egypt	11/4/01		1168/2001		
	Malaysia	6/15/01		PI20012807		
	Pakistan	6/15/01		552/2001		
	Paraguay	6/15/01		N/A		
	Peru	6/15/01		584/2001		
	Philippines	6/15/01		2001-01499		
	Uruguay	6/15/01		26.779		
	Venezuela	6/15/01		1265-2001		

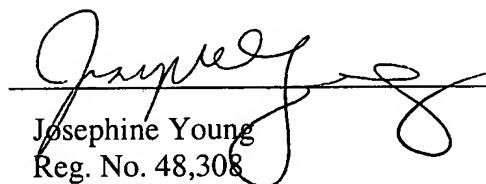
TITLE & DOCKET NAME	COUNTRY	FILING DATE	INVENTORS	SERIAL NUMBER	PATENT NUMBER	ISSUE DATE
NOV 1010 $\beta$ -D-3'-Halo-3'-Deoxy- Arabinonucleoside For The Treatment Of Hepatitis B	Taiwan Thailand	6/15/01 6/15/01	Gilles Gosselin Jean-Louis Imbach Jean-Pierre Sommadossi	90114380 066273	60/283,273	

06171.105004

RESPONSE TO OFFICE ACTION  
U.S.S.N.: 10/022,276  
Filed: December 14, 2001  
Docket No. 06171.105005 (NOV 1000 CON US)

**CERTIFICATE OF MAILING UNDER 37 CFR § 1.8 (a)**

I hereby certify that the Response to Office Action, Petition for One Month Extension of Time, Terminal Disclaimer, Supplemental Information Disclosure Statement, and Transmittal of Information Disclosure Statement, along with any paper referred to as being attached or enclosed, is being deposited with the United States Postal Service on the date shown below with sufficient postage as first-class mail in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.



Josephine Young  
Reg. No. 48,308

Date: July 17, 2002

SUBJECT DECISION ON TERMINAL DISCLAIMERS INFORMAL FORM

DATE: 8-6-02

APPL. S.N.: 101022,276

TO EXAMINER: L. Crane

ART UNIT: 1623

MOSE MONTGOMERY, ROOM 11E18

MAILROOM DATE 7-23-02

AFTER FINAL YES NO NUMBER OF T.D(S). FILED 1

INSTRUCTIONS: I have reviewed the submitted T.D. with the results as set forth below. If you agree, please use the appropriate form paragraphs identified by this Informal memo in your next office action to notify applicant about the T.D. If you disagree with my analysis or have questions at all about the acceptability of the T.D., please see me or our Special Program Examiner. THIS MEMO IS AN INFORMAL, INTERNAL MEMO ONLY. IT MUST NOT BE MAILED TO APPLICANT, NOR SHOULD A COPY BE IN LEFT IN FILE.

The T.D. is PROPER and has been recorded. (See 14.23).

The T.D. is NOT PROPER and has not been accepted for the reason(s) checked below. (See 14.24).

The recording fee of \$\_\_\_\_\_ has not been submitted nor is there any pre authorization in the application file to charge to a deposit account. (See 14.26.07)

Application Examiner has not processed T.D. fee. (See fee authorization).

The T.D. does not satisfy Rule 321(b)(3) in that the person who has signed the T.D. has not stated his/her interest (and/or the extent of the interest of the business entity represented by the signature) in the application/patent. (See 14.26 and 14.26.01).

The T.D. lacks the enforceable only during the common ownership clause needed to overcome a double patenting rejection, Rule 321(c). (See 14.27, 14.27.01).

It is directed to a particular claims(s), which is not acceptable since "the disclaimer must be of a terminal portion of the term of the entire patent to be granted". MPEP 1490. (See 14.26, 14.26.02).

The person who signed the terminal disclaimer:

has failed to state his/her capacity to sign for the business entity, (See 14.28).

is not recognized as an officer of the assignee, (See 14.29 and possibly 14.29.01).

No documentary evidence of a chain of title from the original inventor(s) to assignee has been submitted, nor is the reel and frame specified as to where such evidence is recorded in the office. 37 CFR 3.73(b). (See 1140 O.G. 72). NOTE: This documentary evidence or the specifying of the reel and frame may be found in the T.D. or in a separate paper submitted by applicant. (See 14.30).

No "statement" specifying that the evidentiary documents have been reviewed and that, to the best of the assignee's knowledge and belief the title is in the assignee seeking to take action. 37 CFR 3.73(b). (See 1140 O.G. 72) (See 14.31).

The T.D. is not signed. (See 14.26, 14.26.3), or 14.26.03 if TD is not signed by all the owners.

Attorney not of record in oath/decl. or a separate paper filed appointing a new or associate attorney. (See 14.29.01).

The serial number of the application (or the number of the patent) which forms the basis for the double patenting is missing or incorrect. (See 14.32).

The serial number of this application (or the number of the patent in reexam or reissue case(s) being disclaimed) is missing or incorrect. (See 14.26, 14.26.04 or 14.26.05).

The period disclaimed is incorrect or not specified. (See 14.27, 14.27.2 or 14.27.3) (For Samples 14.27.04 and 14.27.05)

Other: \_\_\_\_\_

Suggestion to request refund of \$\_\_\_\_\_. (See 14.35, 14.36).

EXAMINER NOTE: IF APPLICATION IS IN CONDITION FOR ALLOWANCE ANY OF THE ABOVE INFORMALITIES MAY BE FAXED IN TO THE GROUP

FOR SAMPLE TERMINAL DISCLAIMERS AND CERTIFICATES:

Sample of a TD over a pending application and assignee Certificate (See 14.37).

Sample of a TD over a prior patent and assignee Certificate (See 14.38).

Sample Assignee Certificate under 37 CFR 3.73 (b) (See 14.39)